

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,779	03/30/2001	Wolfgang Wichert	WICHERT ET AL-1	6407
7590 08/12/2004			EXAMINER	
COLLARD & ROE, P.C. 1077 Northern Boulevard Roslyn, NY 11576			HILLERY, NATHAN	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,779

Applicant(s)

WICHERT ET AL.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed on 3/30/01.
2. Claims 1 – 5 are pending in the case. Claim 1 is independent.

Priority

3. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 – 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodge et al. (US5655130A).
8. **Regarding independent claim 1**, Dodge et al. teach *a system and method for producing a variety of documents from a common document database. A document is partitioned into a number of encapsulated data elements. One or more classes of*

Art Unit: 2176

variations are defined and variation names are associated with each class. Data elements within the document are tagged with one or more variation names and placed within a document database; the resulting document database can be filtered and formatted to form variation-specific documents (Column 4, lines 8 – 16), which provide for a data bank (document database), having data objects (encapsulated data element) filed in a media-neutral data bank format; that a document having a plurality of encapsulated data elements and a set of rules detailing a relationship between the encapsulated data elements is provided. Each encapsulated data element may be associated with one or more classes, wherein each class includes a plurality of variation names. A document is created by selecting a set of the variation names of data elements to be included in the document and then collecting a set of data elements having those attributes as a filtered data file. The filtered data file is formatted and output as a custom document (Column 4, lines 18 – 28), which provide for at least one program module for linking said data objects filed in said data bank to documents; and at least one program module for outputting the documents in at least one output format. Dodge et al. do not explicitly teach converting the digital media into said data objects in the media-neutral data bank format. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to modify the invention of Dodge et al. to provide at least one program module for converting the digital media into said data objects in the media-neutral data bank format, since Dodge et al. teach that data elements stored in data storage device 72 or 79 are stored without formatting information. In such an

embodiment, the media formatter/search software provides the formatting rules for each type of media supported by system 40 (Column 9, lines 22 – 26) and since the skilled artisan knows that items in a database are usually stored in a universal format for easy manipulation of data.

9. **Regarding dependent claim 2**, Dodge et al. teach that *a document is partitioned into a number of encapsulated data elements. One or more classes of variations are defined and variation names are associated with each class. Data elements within the document are tagged with one or more variation names and placed within a document database; the resulting document database can be filtered and formatted to form variation-specific documents (Column 4, lines 10 – 16), which provide for a program module for extracting data objects from documents.*

10. **Regarding dependent claim 3**, Dodge et al. teach that *a document having a plurality of encapsulated data elements and a set of rules detailing a relationship between the encapsulated data elements is provided (Column 4, lines 18 – 21), which provide that said program module is rule-based for automatically linking data objects filed in said data bank into documents.*

11. **Regarding dependent claim 4**, Dodge et al. teach that *document filter 60 can determine that there is a single class ("Platform") containing four variations; the values of the cds attributes associated with those variations are: "plat-a", "plat-b", "plat-c", and "plat-d". Therefore, if the user specified that "plat-d" should be filtered ... this example would result in one of the variety of output documents shown in FIG. 3 (where plat-a, plat-b, and plat-c are represented by &, @, and \$, respectively) (Column 10, line 67 –*

Art Unit: 2176

Column 11, line 8), which provide **a user interface for linking said data objects filed in said data bank.**

12. **Regarding dependent claim 5**, Dodge et al. disclose in Figs 6a and 6b that **the documents can be output in a page written language.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOSEPH H. FEILD
PRIMARY EXAMINER

NH